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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,714	09/07/2000	Masaaki Satou	Q60692	2128
7590	06/17/2005		EXAMINER	
Sughrue Mion Zinn MacPeak & Seas PLLC 2100 Pennsylvania Avenue N W Washington, DC 20037-3213			POLLACK, MELVIN H	
		ART UNIT	PAPER NUMBER	
		2145		

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/656,714	SATOU, MASAAKI
	Examiner	Art Unit
	Melvin H. Pollack	2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 March 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13-22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 13-22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 07 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: see attached office action.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection and on the grounds that claims 1-12 have been cancelled.
2. Applicant's arguments filed 15 March 2005 have been fully considered but they are not persuasive. A discussion of the arguments is provided below.
3. In the response to the last office action, the applicant changed the scope of the claims by deleting all the original claims and adding several new claims that are similar but which add new limitations. As a result, a final amendment is necessitated even if the examiner provides a new art rejection. The examiner acknowledges that no new matter has been added by this amendment.
4. As claims 1-12 have been cancelled, the original 112 rejection is removed.
5. Applicant alleges that Shobu does not expressly disclose "a transmission means, as claimed, transmitting a large volume of data upon reception of a notification of data transmission allowance and not transmitting the large volume of data upon reception of data transmission non-allowance from a client terminal (P. 8, lines 19-22)." Shobu clearly shows that data is transmitted or not transmitted based on a notification reply of allowance or non-allowance (Figs. 5 and 6, "CONN"). Hence, this portion is taught.
6. Applicant alleges that Shobu does not expressly disclose "at least if data is not larger than a predetermined volume, transmitting the data via a D-channel and if the data is larger than a predetermined volume, transmitting a notification from a server to a client (P. 9, lines 1-4)." Shobu teaches this limitation (Fig. 2, #103 and #110), but does not expressly disclose

transmitting small data along a D channel. Hence, a new teaching will be brought in to disclose this area.

7. For the above reasons, the rejection is final.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Shobu et al.

(5,692,130).

10. For claim 13, Shobu teaches (abstract) a server-client system (col. 1, line 1 – col. 2, line 40),

a. Wherein a client terminal (Fig. 4; called terminal) is connected to a server (Fig. 4; calling terminal) through an ISDN network (Fig. 4; ISDN);

b. Wherein said server comprises

i. Notification means for transmitting to said client terminal, via a D-channel (Fig. 1, 5b), a notification that a large volume of data is to be transmitted (Fig. 2, #104), when data, whose volume is greater than a predetermined volume, is generated (Fig. 2, #103),

ii. Transmission means for transmitting the large volume of data to said client terminal (Fig. 5, #108) via a B-channel (Fig. 1, #5c and 5d), upon reception of a notification of data transmission allowance from said client terminal (Fig. 5,

#113), and for not transmitting the large volume of data to said client terminal (Fig. 5, #109) upon reception of a notification of data transmission non-allowance from said client terminal (Fig. 5, #107); and

c. Wherein said client terminal comprises

- i. Monitoring means for monitoring a state of all B-channel lines between said client terminal and said server (Fig. 7, #205), upon reception of the notification that a large volume of data is to be transmitted from said server (Fig. 7, #201);
- ii. A transmission allowance notification means for transmitting to said server, via a D-channel, the notification of data transmission allowance when two or more B-channel lines are free (Fig. 7, #206) and for transmitting to said server, via a D-channel, the notification of data transmission non-allowance when two or more B-channel lines are not free (Fig. 7, #211-213).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu as applied to claim 13 above, and further in view of Yoshida (5,594,867).

13. For claim 14, Shobu does not expressly disclose that said client terminal further comprises determining means for determining, upon reception of the notification that a large

volume of data is to be transmitted from said server, if the reception is within a B-channel use-allowed time interval, wherein said transmission allowance notification means only transmits a notification of data transmission allowance to said server if the reception is within the B-channel use-allowed time interval. Yoshida teaches a method (abstract) of handling data transmission communications (col. 1, line 1 – col. 2, line 40) in which the recipient (Fig. 3, #S94) checks to determine if the transmission is received within two time points (Fig. 3, #S98), and performs transmission if between those two points (Fig. 3, #S100) and non-transmission if it does not (Fig. 3, #S102). At the time the invention was made, one of ordinary skill in the art would have utilized Yoshida in order to manage pre-existing data methods and to automate data management processes (col. 2, lines 10-25).

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu as applied to claim 13 above, and further in view of Corrigan et al. (5,966,636).

15. For claim 15, Shobu does not expressly disclose that, upon reception of the notification of data transmission non-allowance from said client terminal, said notification means of said server retransmits to said client terminal, via a D-channel, the notification that a large volume of data is to be transmitted, upon a lapse of a predetermined period of time. Corrigan teaches a method (abstract) of data communications (col. 1, lines 1- 40) in which a failure to communicate results in a delay, after which transmission is attempted again (Fig. 10, #1030). At the time the invention was made, one of ordinary skill in the art would have added Corrigan's time-delay method to Shobu in order to ensure that data is eventually delivered (col. 11, lines 45-55).

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu as applied to claim 13 above, and further in view of Gregory (5,909,673).

17. For claim 16, Shobu does not expressly disclose that, instead of transmitting the notification of data transmission allowance, said transmission allowance notification means conducts calling to said server for downloading the large volume of data. Gregory teaches a method (abstract) of data processing systems (col. 1, line 1 – col. 7, line 35) with this limitation (col. 6, lines 23-40). At the time the invention was made, one of ordinary skill in the art would have added this form of downloading to ensure that the client receives the proper elements from the server (col. 3, lines 59-63).

18. Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu as applied to claim 13 above, and further in view of Takashima (EP 0 355 777 A2).

19. Claim 17 is drawn to the limitations in claim 13. Shobu does not expressly disclose transmitting, via a D-channel, data transmission time. Shobu also does not expressly disclose announcing means for announcing the data transmission time to a user, upon reception of the data transmission time and the notification that a large volume of data is to be transmitted from said server, and authorization means for enabling a user to authorize the transmission that a large volume of data is to be transmitted from said server. Takashima teaches a method (abstract) of data communications within an ISDN network (col. 1, line 1 – col. 3, line 5) in which data transmission information is displayed (Fig. 9) and in which a notification display (Fig. 10, #110) and key for notification acceptance (Fig. 10, #111) is used. At the time the invention was made, one of ordinary skill in the art would have utilized these items in order to provide a user with

caller information before a connection is made (col. 2, lines 5-25). Therefore, since claim 13 is rejected, claim 17 is also rejected for the reasons above.

20. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu as applied to claim 13 above, and further in view of Griefer (5,615,213).

21. Claim 18 is drawn to the limitations in claim 13. Shobu teaches that, if the volume of data to be transmitted is larger than a predetermined amount, the method of claim 13 occurs (Fig. 2, #103) and if not, data is transmitted in “normal mode” (Fig. 2, #110), but does not expressly disclose that the small data is transmitted via D-channel. Griefer teaches a method (abstract) of transmitting data over an ISDN network (col. 1, line 1 – col. 3, line 50) in which data greater than a limit (Fig. 3, #110) is sent via B-channel (Fig. 3, #104), and data lower than a limit is sent via the D-channel (Fig. 3, #112). At the time the invention was made, one of ordinary skill in the art would have transmitted some data over the D-channel in order to incur fewer costs (col. 4, lines 5-20). Therefore, since claim 13 is rejected, claim 18 is also rejected for the reasons above.

22. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu and Griefer as applied to claim 18 above, and further in view of Yoshida, as applied to claim 14 above.

23. Claim 19 is drawn to the limitations in claim 14. Therefore, since claim 14 is rejected, claim 19 is also rejected for the reasons above.

24. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu and Griefer as applied to claim 18 above, and further in view of Corrigan, as applied to claim 15 above.

25. Claim 20 is drawn to the limitations in claim 15. Therefore, since claim 15 is rejected, claim 20 is also rejected for the reasons above.

26. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shobu and Griefer as applied to claim 18 above, and further in view of Gregory, as applied to claim 16 above.

27. Claim 21 is drawn to the limitations in claim 16. Therefore, since claim 16 is rejected, claim 21 is also rejected for the reasons above.

***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

29. Communications Monitoring: Shaffer (EP0848560A2, US 5,898,668), Morita (EP0497000A2), Yamanaka (article)

30. ISDN communication and integration: Buchanan (US 5,991,293, EP0880259A2), Abrahamsson (WO 98/51115), Nakatsuka (EP0719044B1), Cho (US 5,289,472)

31. ISDN Transmission and Notification: Tejima (JP05344251A), Kessler (book excerpt)  
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887.  
The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP  
09 June 2005

*v. martinwallace*  
VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER